

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. MBHB 08-985-WO-US)

In re Application of:)	
)	
Erwan Pincemin)	
)	Examiner: Li Liu
Serial No. 10/511,227)	
)	Art Unit: 2613
Filed: May 24, 2005)	
)	Confirmation No. 2078
For: An Optical Device and a Method for)	
Converting WDM Signals into an)	
OTDM Signal and Vice Versa)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT

Dear Sir:

Applicant requests reconsideration of the patent term adjustment in light of the recent *Wyeth v. Dudas* decision (D.D.C., Memorandum Opinion for Case No. 07-1492, Sept. 30, 2008).

Applicant agrees with the Office's Patent Term Adjustment of A delay minus Applicant Delay of 364 days. Based on a July 10, 2008 date for filing an RCE, Applicant submits the B delay is 391 days. After taking A delay and B delay overlap into account, Applicant requests reconsideration of Patent Term Adjustment to 748 days total.

The Office is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 13-2490 for this request for reconsideration of patent term adjustment.

A. Definition of A Delay and B Delay

According to *Wyeth*, there are three guarantees of patent term under 35 U.S.C. § 154(b). The first, termed "A delay", are extensions due to delays by the PTO beyond statutory deadlines, such as fourteen months for a first response on the merits, four months to issue an office action after a response, and four months to issue a patent after the fee is paid. *Wyeth*, p. 3. The second, termed "B delay", is a "a one-day term extension [that] is granted for every day greater than

three years after the filing date that it takes for the patent to issue, **regardless of whether the delay is the fault of the PTO**” *Id.* (emphasis added). The third, termed “C delays”, concerning delays due to interferences, secrecy delays and appeals was not substantively addressed by *Wyeth. Id.*

35 U.S.C. § 154 also reduces patent term adjustment due to delays by the applicant for the period of time where an applicant failed to engage in reasonable efforts to conclude prosecution of the application. 35 U.S.C. § 154(b)(2)(C)(i). Specifically, the statute defines failing to engage in reasonable efforts to conclude prosecution for any periods of time “in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.” 35 U.S.C. § 154(b)(2)(C)(ii). For purposes of this request, A delay includes reduction in patent term due to delays by the Applicant.

B. Application Summary

The total patent term adjustment indicated on the Determination of Patent Term Adjustment for this application is 364 days. The table on the next page indicates key dates in this application.

Date	Event	A Delay	B Delay	Applicant Delay
April 19, 2002	France Pat. App. 02/04968 filed (priority filing)			
March 13, 2003	EPO Filing			
October 12, 2004	US National Stage Application Filed			
October 19, 2004	30 months from Priority filing. National Stage Commences under 37 CFR § 1.491(a).			
May 24, 2005	Applicant completes 35 USC § 371 requirements. U.S. Filing Date set.			
July 24, 2006	14 months after U.S. Filing Date	X		
October 19, 2007	3 year anniversary of National Stage Commencement. B Delay begins.	X	X	
October 26, 2007	Non-final Office Action (NFOA) Mailed.	X	X	
January 26, 2008	3 months after Non-final Office Action Mailed		X	X
April 28, 2008	Response to NFOA mailed via first class mail		X	X
April 30, 2008	Response to NFOA received at PTO		X	X
October 13, 2008	Final Office Action (FOA) mailed		X	
November 13, 2008	Response to FOA with RCE filed. B Delay Ends		X	
January 13, 2009	Supplemental Response to FOA filed			
January 27, 2009	Notice of Allowance mailed			

An “X” in the A Delay, B Delay, or Applicant Delay column in the table above indicates the Applicant believes the respective delay accrues between consecutive dates with “X” signs. For example, as shown in the table above, Applicant believes that A delay was accrued between July 24, 2006 and October 26, 2007.

C. Calculation of A Delay and Applicant Delay

For the A delay and Applicant delay calculations, the Patent Term Adjustments (PTA) on PAIR for this application indicate a total of 364 days. Applicant agrees with the PTA calculation on PAIR of 364 days for this application with respect to A delay and Applicant delay.

D. B Delay Calculation

France Pat. App. 02/04968, the priority filing for this application, was filed on April 19, 2002. 37 C.F.R. § 1.703(b) states that “The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after...the national stage commenced under 35 U.S.C. § 371(b) or (f) in an international application.” The national stage is commenced, according to 37 C.F.R. § 1.491(a), “with the expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a).”

PCT Article 22(1) states, in part, “Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for the State not later than at the **expiration of 30 months from the priority date**” (emphasis added). PCT Article 22(2) refers to PCT Article 22(1) for time limits when no international search report is filed. *See* PCT Article 22(2).

PCT Article 39(1) states that “[i]f the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each elected Office not later than at the **expiration of 30 months from the priority date**” (emphasis added).

Thus, the U.S. National Stage commences 30 months after the priority date. For this application, the U.S. National Stage commenced on October 19, 2004. The three year anniversary of U.S. National Stage commencement is October 19, 2007.

Applicant submits the B delay period or “B period” is the time from the day after the 3 year anniversary (or October 19, 2007) until either a patent issues for the application, an RCE is filed for the application, or for other reasons that are not applicable to this application (*e.g.*, interferences and Applicant-requested delays). *See* 35 U.S.C. § 154(b)(1). Specifically, an RCE was filed for this application on November 13, 2008. Applicant therefore submits the B delay period is the time from October 19, 2007 to November 13, 2008 for a total of 391 days.

E. Requested Patent Term Adjustment

The *Wyeth* decision states that “the ‘A period’ and ‘B period’ overlap only if they occur on the same calendar day or days.” *Wyeth*, p. 8. Thus, according to the *Wyeth* decision, Patentees are entitled to both the A delay” and the actual B delay minus any overlap which occurs on the same calendar days. As indicated in the table above, there is an overlap of 7 days between the A period and the B period during the interval of October 19, 2007 and October 26, 2007. Thus, the total Patent Term Adjustment due to both the “A” and “B” delays minus the overlap and Applicant delay is $364+391-7 = \underline{748}$ days.

Therefore Applicant respectfully requests that the estimated Patent Term Adjustment for this case **should be increased from 364 days to 748 days**.

If a telephone conference would expedite this Request for Reconsideration of Patent Term Adjustment, please contact the undersigned attorney at (312) 913-3338.

Respectfully submitted,
McDonnell Boehnen
Hulbert & Berghoff LLP

Date: April 27, 2009

By: /Thomas J. Loos/
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